

REMARKS

Claims 1-7 are now pending in the application. Claims 8-11 are added. Pending claims 1-7 stand rejected under 35 U.S.C. § 102 (e). The following remarks are considered by Applicants to overcome each rejection raised by the Examiner and to place the application in condition for allowance. An early Notice of Allowance is therefore requested.

I. Rejection Of Pending Claims 1-4 and 7 Under Double Patenting

The Examiner provisionally rejects claims 1-4 and 7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of copending application No. 10/387,739. The Examiner claims that although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap the published claims and thus would be rendered obvious.

Since this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented, Applicants respectfully submit that Applicants will not address the issue of a Terminal Disclaimer until subject matter is allowed by the Examiner.

II. Rejection Of Pending Claims 1-3 and 7 Under 35 U.S.C. § 102 (e)

The Examiner has rejected claims 1-3 and 7 under 35 U.S.C. § 102 (e) as being anticipated by Momose, U.S. Patent No. 6,695,900, issued February 24, 2004 ("Momose"). Applicants respectfully traverse this rejection.

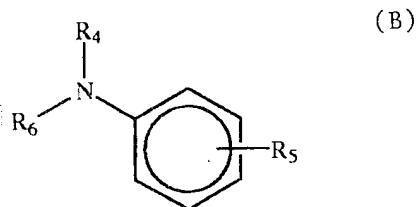
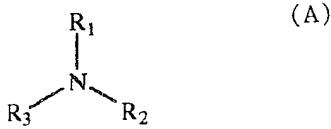
A. Relevant Law

"A claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Bristol-Myers Squibb v. Ben Venue*, 246 F.3d 1368, 1374 (Fed. Cir. 2001). Identity of invention requires that a prior reference disclose to one of ordinary skill in the art all elements and limitations of the patent claim. *Scripps Clinic v. Genentech*, 927 F.2d

1565, 1576 (Fed. Cir. 1991). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986).

B. Summary of Cited References

Momose discloses an aqueous ink composition comprising at least a surface modified pigment capable of at least one of dispersing and dissolving in an aqueous solvent without use of a dispersant; an organic amine compound represented by formula (A) or (B) shown below; water,



wherein R₁ to R₆ each independently represents a hydrogen atom or an alkyl or hydroxyalkyl chain having from 1 to 8 carbon atoms, which may have a branch, provided that at least one of R₁ to R₃ is an alkyl or hydroxyalkyl chain having from 3 to 8 carbon atoms, which may have a branch. Also, the present invention discloses an aqueous ink composition comprising at least a pigment, a dispersant, an organic amine compound represented by formula (A) or (B) shown below, a penetration accelerator and water.

C. Argument

Currently amended claim 1 discloses an ink for ink-jet recording comprising an anionic self-dispersing coloring agent, a surfactant having both of a cationic moiety and a nonionic moiety, and water. Claim 1 further discloses a curve, which represents a change of surface tension of the ink with respect to a concentration of the surfactant, has one inflection point, the curve has a first local maximum point and a second local maximum point on a low concentration side and on a high concentration side of the inflection point respectively, and a concentration of

the surfactant contained in the ink is higher than a concentration corresponding to the first local maximum point.

Although Momose teaches an aqueous ink composition, Applicants agree with the Examiner that Momose reference remains silent to the curve that represents a change of surface tension the ink. In addition, Momose does not disclose an ink for ink-jet recording comprising an anionic self-dispersing coloring agent, a surfactant having both of a cationic moiety and a nonionic moiety, and water like the present invention. Further, Momose does not disclose that the surfactant in the ink composition exhibits a strong interaction with the anionic self-dispersing type microparticulate coloring agent like the present invention. Momose instead discloses that the organic amine compound in the ink composition is an alkali agent used for adjusting the pH of the aqueous ink composition to a desired range. See Column 4, lines 30-33. This is unlike the present invention where it is disclosed that the relationship between the anionic self-dispersing coloring agent and a surfactant having both of a cationic moiety and a nonionic moiety is that the cationic moiety adheres to the anionic self-dispersing type microparticulate coloring agent and the nonionic moiety prevents the self-dispersing type microparticulate coloring agent from aggregation and sedimentation. See paragraph [0025].

Accordingly, Momose fails to teach or disclose each and every limitation of independent claim 1. To the extent that the Examiner finds each and every limitation of claim 1 in Momose, it nonetheless is insufficient for it does not contain an enabling disclosure. Therefore, Momose does not anticipate claim 1. Claims 2-7, by virtue of their dependency from claim 1, are similarly considered by Applicants to patentably define themselves and are novel over Momose.

III. Allowable Subject Matter

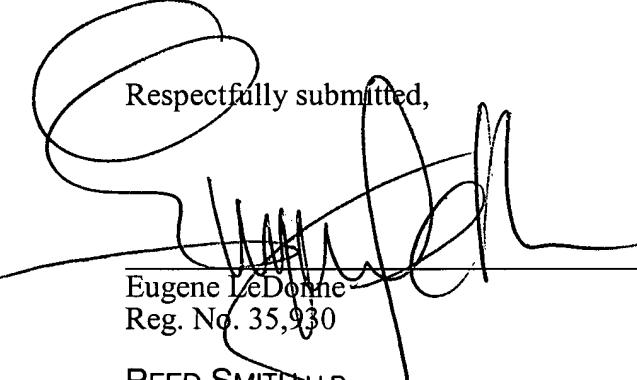
Applicants gratefully acknowledge the Examiner notation on page 4 of the office action that claims 5 and 6 would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

VI. New Claims

Claims 8-11 are added. No new matter is presented. Claim 8 recites features that are neither taught nor suggested by the applied reference. It is respectfully submitted that Momose does not teach or suggest the features recited in claim 8, since claim 8 recites subject matter recited in claim 4. Claims 9-11 are dependent upon claim 8. Therefore, Applicants request the consideration and allowance of claims 8-11.

V. Conclusion

For the reasons presented above, claims 1-11, all the claims pending in the application, are believed by Applicants to define patentable subject matter and should be passed to issue at the earliest possible time. A Notice of Allowance is requested.

Respectfully submitted,

Eugene LeDonne
Reg. No. 35,930
REED SMITH LLP
599 Lexington Avenue
New York, NY 10022
(P) 212-521-5402

Attorney for Applicant